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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER
MAHMOUDI, HASSAN

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 December 2003*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *19-44* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *19-31,34-37 and 39-44* is/are rejected.

7)☒ Claim(s) *32,33 and 38* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

DOV POPOVICI
. SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Remarks

1. In response to communications filed on 08-December-2003, the abstract of the disclosure is amended, claims 1-18 are cancelled and new claims 19-44 are added per applicant's request. Therefore, claims 19-44 are presently pending in the application.

Specification

2. The arrangement of the disclosed application does not conform with 37 CFR 1.77(b). Section heading appear underlined and in lowercase style throughout the disclosed specification. Section headings should not be underlined, and should appear in UPPER CASE style. Appropriate corrections are required according to the guidelines provided below:

3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

(a) TITLE OF THE INVENTION.
(b) CROSS-REFERENCE TO RELATED APPLICATIONS.
(c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR
    DEVELOPMENT.

(d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A
      COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program
      listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables
      having more than 50 pages of text are permitted to be submitted on compact
      discs.) or
      REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a).
      "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
(e) BACKGROUND OF THE INVENTION.
      (1) Field of the Invention.
      (2) Description of Related Art including information disclosed under 37 CFR 1.97
      and 1.98.
(f) BRIEF SUMMARY OF THE INVENTION.
(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
(h) DETAILED DESCRIPTION OF THE INVENTION.
(i) CLAIM OR CLAIMS (commencing on a separate sheet).
(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence
      Listing" is required on paper if the application discloses a nucleotide or amino
      acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence
      Listing" is not submitted as an electronic document on compact disc).

Claim Objections

4. Claim 25 is objected to under 37 CFR 1.75(c), as being of improper dependent form for

failing to further limit the subject matter of a previous claim.

Claim 25 recites the limitation "a domain name registration system" in line 1. Since

claim 25 depends on the base claim 1, recitation of a "a registration system" to further limit a

"method" claim is improper. Applicant is required to cancel the claim(s), or amend the

claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in

independent form.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 19-20, 22-28, 30-31, 34-36, 39-41, and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann et al (U.S. Patent No. 6,519,589) in view of Broadhurst (U.S. Patent No. 6,560,634), and further in view of Ryan (U.S. Patent No. 6,412,014.)

As to claim 19, Mann et al teaches a method of facilitating availability checking and registration of domain names (see Abstract), the method comprising:

providing an electronic form (see figure 5A) for allowing a user to specify a plurality of names (see figure 5A, block 504) to be checked for availability in a domain name registry database (see column 5, lines 54-66, and see column 6, line 66 through column 7, line 26);

receiving a set of names specified by the user from the form, the set of names comprising a plurality of names to be checked (see Abstract; see column 2, lines 55-56; and see column 7, lines 10-26);

querying a registry database (see column 2, lines 58-63, where "querying a data source" is taught; and see column 5, lines 61-66) to check an availability of each of the plurality of names with each of a plurality (see column 6, lines 11-17), of Top Level Domain (TLD) extensions (see column 7, lines 18-26, and see column 8, lines 56-63); and

generating and returning to the user a query results display (see figure 5D) showing the

availability of each name in conjunction with each of the plurality of TLD extensions (see

figure 5D, block 514), to formulate a registration request (see figure 5D, where the "Register

Now" hyperlinks, when clicked on by the user, will form a request to register the domain

name) to register a domain name.

Mann et al does not teach the query results display including a table; wherein the table is

presented in conjunction with a user option to select one or more available name-TLD

extension combinations ("domain names"); and whereby the user can formulate a single

request to register a domain name.

Broadhurst teaches a method of determining availability of Internet domain names (see

Abstract), in which he teaches the query results display including a table (see figure 6A);

wherein the table is presented in conjunction with a user option to select one or more

available name-TLD extension combinations ["domain names"] (see figure 6A, column 610,

and see column 3, lines 25-37, where the format of the query any of a number of forms such

as "check boxes" in a graphical user interface); and whereby the user can formulate a single

request to register a domain name (see figures 6A and 6C; see column 2, lines 41-52, and see

column 7, lines 12-26.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the

time the invention was made to have modified Mann et al to include the query results display

including a table; wherein the table is presented in conjunction with a user option to select

one or more available name-TLD extension combinations ("domain names"); and whereby

the user can formulate a single request to register a domain name.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Mann et al by the teachings of Broadhurst because including the query results display including a table; wherein the table is presented in conjunction with a user option to select one or more available name-TLD extension combinations ("domain names"); and whereby the user can formulate a single request to register a domain name, would enable the user to select the domain name(s) of choice from the displayed list of available domain names and form a request to register the desired domain name.

Mann et al as modified still does not teach registering a plurality of domain names.

Ryan teaches an Internet directory (see Abstract), in which he teaches registering a plurality of domain names (see column 3, lines 52-63, and see column 6, lines 28-39.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Mann et al as modified, to include registering a plurality of domain names.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Mann et al as modified, by the teaching of Ryan, because registering a plurality of domain names, would allow the user to avoid repetitive process of searching for, and registering domain names one at a time, by registering a primary domain name, resulting in a plurality of registered domain names available under various top-level-domains, as taught by Ryan (see column 3, lines 52-56.)

As to claims 20, 28, and 41, Mann et al as modified teaches wherein the user option to select one or more available domain names comprises selection check boxes provided within the table, such that a separate check box is provided for each available domain name (see Broadhurst, figure 6A, column 610, and see column 3, lines 25-37, where the format of the query any of a number of forms such as "check boxes" in a graphical user interface.)

As to claims 22, 27, and 40, Mann et al as modified teaches wherein the plurality of TLD extensions are predefined, such that the method is performed without requiring the user to specify each of the plurality of TLD extensions (see Mann et al, column 4, lines 16-23.)

As to claim 23, Mann et al as modified teaches wherein the form permits the user to specify the plurality of names by entering text strings from which the plurality of names are to be derived (see Mann et al, figure 5A, block 504, and see column 7, lines 22-26.)

As to claim 24, Mann et al as modified teaches wherein the form includes a single text window which is suitable for user entry of the plurality names (see Broadhurst, figure 5B.)

As to claim 25, Mann et al as modified teaches a domain name registration System (see Mann et al, Abstract) that operates according to the method of Claim 19 (applicant is directed to remarks and discussions made in claim 19 above.)

As to claim 26, <u>Mann et al</u> teaches a method of checking the availability of domain names for registration (see Abstract), the method comprising:

providing a web form (see figure 5A) allowing a user to specify multiple names to be queried for availability (see figure 5A, block 504) such that the user need not specify associated Top Level Domain (TLD) extensions (see column 4, lines 16-23);

receiving a submission comprising multiple names entered by the user into the web form (see Abstract; see column 2, lines 55-56; and see column 7, lines 10-26);

For the remaining steps of this claim, the applicant is kindly directed to the remarks and discussions made in claim 19 above.

As to claim 30, <u>Mann et al</u> as modified teaches further comprising providing the user an option to specify a plurality of name servers to be associated with each domain name to be registered (see <u>Broadhurst</u>, column 2, lines 41-52, and see column 3, line 66 through column 4, line 15.)

As to claim 31, <u>Mann et al</u> as modified teaches further comprising receiving a single submission from the user (see <u>Broadhurst</u>, figure 5B) specifying multiple domain names to be registered, and submitting the multiple domain names for registration (see <u>Broadhurst</u>, figure 6A, and see <u>Ryan</u>, column 3, lines 52-63, and see column 6, lines 28-39.)

As to claim 34, <u>Mann et al</u> teaches a system for allowing a user to query a database to determine the availability of multiple names for domain name registration, the system comprising:

a web page adapted for user entry and submission of a set of names (see figure 5A) to be checked for domain name registration availability (see Abstract, and see column 2, lines 49-62), wherein the web page allows a user to submit multiple names at a time (applicant is directed to the remarks and discussions made in claim 19 above); and

a server which is responsive to submission from the web page (see column 3, line 66 through column 4, line 8) of a set of multiple names (see column 7, lines 22-26) by at least (a) determining registration availability of each of the names in combination with each of a set of multiple Top Level Domain (TLD) extensions (see column 2, lines 49-62), such that the user need not specify the TLD extensions (see column 4, lines 16-23), and (b) generating a query results display indicating, for each combination of a name and a TLD extension, whether the combination is available for registration, wherein the query results display provides a user option to generate a request to register one or more of the combinations that are available, such that the user may request registration of multiple domain names in a single request (applicant is directed to the remarks and discussions made in claim 19 above.)

As to claim 35, <u>Mann et al</u> as modified teaches wherein the query results display comprises a query results table (see <u>Broadhurst</u>, figure 6A.)

As to claim 36, <u>Mann et al</u> as modified teaches wherein the query results table includes means for selecting one or more available domain names for registration (see <u>Mann et al</u>, figure 5D, and see <u>Broadhurst</u>, figure 6A.)

As to claim 39, <u>Mann et al</u> teaches method of displaying information on the availability of multiple names for registration as domain names (see Abstract, and see figure 5D), the method comprising:

For the remaining steps of this claim, the applicant is kindly directed to the remarks and discussions made in claim 19 above.)

As to claim 43, <u>Mann et al</u> teaches a method of checking domain name registration availability (see Abstract), the method comprising:

displaying a view allowing a user to specify a name to be queried for availability (see figure 5A) as a Second Level Domain (SLD) in a domain name registry database (see column 8, lines 4-30);

receiving from the user the name to be queried for availability as the SLD (see column 8, lines 26-27);

looking up an availability status of the name in combination with each of multiple Top Level Domain (TLD) extensions not specified by the user (see column 8, lines 30-32); and

displaying query results for the name in a table (the applicant is directed to the remarks and discussions made in claim 19 above) showing the availability of the name as a SLD in conjunction with each TLD extension (see column 8, lines 57-67.)

As to claim 44, Mann et al as modified teaches wherein the table is displayed within a web form that permits the user to select multiple domain names from the table and to submit, from said web form, a request to register the multiple domain names, such that multiple domain names may be registered concurrently (for the teachings of this claim, the applicant is kindly directed to the remarks and discussions made in claim 19 above.)

7. Claims 21, 29, 37, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann et al (U.S. Patent No. 6,519,589) in view of Broadhurst (U.S. Patent No. 6,560,634), and further in view of Ryan (U.S. Patent No. 6,412,014), as applied to claims 19-20, 22-28, 30-31, 34-36, 39-41, and 43-44 above, and further in view of Chang et al (U.S. Patent No. 6,539,370.)

As to claims 21, 29, 37, and 42, Mann et al as modified teaches the table includes a separate row for each of the plurality of names (see Mann et al, figure 5D, and see Broadhurst, figure 6A.)

Mann et al as modified still does not teach the table includes a separate column for each of the plurality of TLD extensions.

Chang et al teaches a report generating and viewing method (see Abstract), in which she teaches the table includes a separate column for each of the plurality of TLD extensions (see figures 4, 4A, and 7; see column 4, lines 29-54, and see column 5, lines 26-37.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Mann et al as modified, to include a separate column for each of the plurality of TLD extensions in the table.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Mann et al as modified, by the teaching of Chang et al, because a separate column for each of the plurality of TLD extensions would offer the user all the available domain names under each domain name extension in a single view in order for the user to be able to select the desired domain names and extensions for registration.

Allowable Subject Matter

8. Claims 32, 33, and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record, Mann et al (U.S. Patent No. 6,519,589), Broadhurst (U.S. Patent No. 6,560,634), Ryan (U.S. Patent No. 6,412,014), and Chang et al (U.S. Patent No. 6,539,370), do not disclose, teach, or suggest the claimed limitations of (in combination with all other features in the claim):

after submission of the multiple domain names for registration, generating a display

which includes a second table indicating, for each of the multiple domain names, whether

registration was successful, as claimed in claim 32.

Claim 33 are objected to as being dependent from the objected to dependent claim 32.

The prior art of record, Mann et al (U.S. Patent No. 6,519,589), Broadhurst (U.S. Patent

No. 6,560,634), Ryan (U.S. Patent No. 6,412,014), and Chang et al (U.S. Patent No.

6,539,370), do not disclose, teach, or suggest the claimed limitations of (in combination with

all other features in the claim):

wherein the server is responsive to a request to register multiple domain names by

generating a web page that includes a table indicating, for each of the multiple domain

names, whether registration was successful, as claimed in claim 38.

Response to Arguments

10. Applicant's arguments filed on 08-December-2003 with respect to the rejected claims in view

of the cited references have been fully considered but they are either not found persuasive, or

they are considered moot in view of the new grounds of rejection:

In response to the applicant's argument that the cited references were not appropriate

"prior art" to the claims in view of the applicant's declaration, the argument has been fully

considered but is not deemed persuasive, because the 37 CFR 1.131 affidavit or declaration

must establish possession of either the whole invention claimed or something falling within

the claim (such as a species of a claimed genus), in the sense that the claim as a whole reads

on it. In re Tanczyn, 347 F.2d 830, 146 USPQ 298 (CCPA 1965). See MPEP §715.02.

The affidavit or declaration and exhibits must clearly explain which facts or data

applicant is relying on to show completion of his or her invention prior to the particular date.

Vague and general statements in broad terms about what the exhibits describe along with a

general assertion that the exhibits describe a reduction to practice "amounts essentially to

mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the

requirements of **37 CFR 1.131(b)**. *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA

1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts

are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also *In*

re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but

does not tell what they are or when they occurred.") See GENERAL REQUIREMENTS in

MPEP §715.07.

In this case, the four screen shots accompanying the declaration filed on 08-December-

2003 do not clearly show or explain all facts and limitations of the claimed invention. In one

example, newly added claim 19 recites: *"querying a registry database"* in line 7. None of

the screen shots have any indication that an actual *"query"* is being conducted. The screen

shots do not refer to, indicate, or depict a *"registry database"* or any other data storage

device. In fact, it is not clear from the screen shots as to what the source of the information is

meant to be. In another example, newly added claim 26 recites the limitation of *"receiving*

a submission" in line 6. The screen shots do not indicate or illustrate any means for

"receiving" or *"submitting"* or any such communication between entities. In another

example, newly added claim 33 recites the limitation *"wherein the second table includes*

domain name expiration dates". Again, none of the screenshots illustrate or indicate wither

a *"second table"* or *"domain name expiration date"*. In another instance, newly added

claim 34 recites *"a server which is responsive to submission from the web page"*. None of

the screen shots depict or illustrate a *"server"* in communication with the web page.

In general, proof of actual reduction to practice requires a showing that the apparatus

actually *existed* and *worked* for its intended purpose. See "THREE WAYS TO SHOW PRIOR

INVENTION" in MPEP §715.07. The screen shots provided by the applicant simply illustrate

a concept of domain name registration but do not provide any proof that the invention

illustrated by screen shots actually worked successfully at the time of reduction to practice.

In view of the above examples and the requirements set forth by the MPEP, the examiner

is maintaining the validity of the references cited in the previous and the present Office

Actions as appropriate "prior art" to the claims of the present invention.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office

action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until

after the end of the THREE-MONTH shortened statutory period, then the shortened statutory

period will expire on the date the advisory action is mailed, and any extension fee pursuant to

37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of

this final action.

12. Any inquiries concerning this communication or earlier communications from the examiner

should be directed to Tony Mahmoudi whose telephone number is (703) 305-4887. The

examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Dov Popovici, can be reached at (703) 305-3830.

tm

February 20, 2004

DOV POPOVICI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100